

REMARKS

Applicant appreciates the Examiner's review of the above-identified patent application and respectfully requests reconsideration and allowance in view of the above amendments and following remarks.

In the present Office Action, the Examiner states that the claims in the present application are directed to three, patentably distinct inventions, namely, invention I (claims 21-31), II (claims 32-43), and III (claim 44). Applicant respectfully traverses this conclusion and respectfully requests reconsideration for the reasons explained hereinbelow. Applicant also provisionally elects invention I.

MPEP § 803 states, in relevant part, "If the search and examination of all the claims in an application **can be made without serious burden**, the examiner **must** examine them on the merits, even though they include claims to independent or distinct inventions." Moreover, MPEP § 806.05(c) states, in relevant part,

To support a requirement for restriction between combination and subcombination inventions, both two-way distinctness and reasons for insisting on restriction are necessary, i.e., there would be a serious [sic] search burden as evidenced by separate classification, status, or field of search. See MPEP § 808.02.

Finally, MPEP § 808.02 states:

Where, as disclosed in the application, the several inventions claimed are related, and such related inventions are not patentably distinct as claimed, restriction under 35 U.S.C. 121 is never proper (MPEP § 806.05). If applicant voluntarily files claims to such related inventions in different applications, double patenting may be held.

Where the related inventions as claimed are shown to be independent or distinct under the criteria of MPEP § 806.05(c) - § 806.06, the examiner, in order to establish reasons for insisting upon restriction, **must explain** why there would be a serious burden on the examiner if restriction is not required. **Thus the examiner must show by appropriate explanation one of the following:**

(A) **Separate classification thereof:** This shows that each invention has attained recognition in the art as a separate subject for inventive effort, and also a separate field of search. Patents need not be cited to show separate classification.

(B) **A separate status in the art when they are classifiable together:** Even though they are classified together, each invention can be shown to have formed a separate subject for inventive effort when the examiner can show a recognition of separate inventive effort by inventors. Separate status in the art may be shown by citing patents which are evidence of such separate status, and also of a separate field of search.

(C) **A different field of search:** Where it is necessary to search for one of the inventions in a manner that is not likely to result in finding art pertinent to the other invention(s) (e.g., searching different classes/subclasses or electronic resources, or employing different search queries, a different field of search is shown, even though the two are classified together. The indicated different field of search must in fact be pertinent to the type of subject matter covered by the claims. Patents need not be cited to show different fields of search.

Where, however, the classification is the same and the field

of search is the same and there is no clear indication of separate future classification and field of search, no reasons exist for dividing among independent or related inventions.

Applicant respectfully submits that the Examiner has failed to establish why there is a "serious burden" on the Examiner and has failed to provide the reasons explaining why there exists a "serious burden" such as separate classification, status, or field of search. Accordingly, Applicant respectfully submits the present restriction requirement is improper and requests that the Examiner withdraw the present restriction requirement and examine all the pending claims on the merits. Applicants further submits that it would be improper to make a subsequent Office Action examining all the claims on the merits final since the present restriction requirement is improper and not all the claims have been examined on the merits.

Claims 21, 22, and 30 have been rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. With this amendment, Applicant has amended the claims and respectfully submits that the rejection has been overcome.

Claims 21, 22, 24, and 29 have been rejected under 35 U.S.C. § 102(b) as being anticipated by Simpson et al. Claim 30 has been

rejected under 35 U.S.C. § 103(a) as being unpatentable over Simpson et al. Applicant respectfully traverses these rejections.

In the present Office Action, the Examiner states,

Simpson et al. teach that the substrate includes a region disposed along at least a first edge of the substrate (edge of substrate 92, Fig. 9) where the second region has an upper and a lower surface (the upper portion of the edge of the substrate 92 and the lower portion of the edge of the substrate 92) that are both free of both the first and the second asphalt composition.

Applicant respectfully submits that Simpson et al. does not disclose or suggest these limitations. Moreover, the Examiner has failed to point out where Simpson et al. allegedly discloses these limitations.

Fig. 9 to which the Examiner refers to clearly indicates that the lower surfaces of the substrate 92 is covered with adhesive layer 94. This is further supported by the specification that states, "One surface of the impregnated mat 92 is coated with an adhesive 94." See column 5, lines 52-51. Moreover, Simpson et al. states, "The upper surface of the adhered underlayment [90] is somewhat roughened in texture due to the unwoven polyester fibers and thereby provides an enhanced ability to bond securely to itself (layer 94) at overlaps and to bitumen layer 24 of roofing

10." See column 5, lines 56-62.

Accordingly, Simpson et al. clearly states the entire bottom surface of the substrate 92 is coated with the adhesive layer 94, even at the edges where the underlayment 90 overlaps. There is nothing in Simpson et al. which teaches or suggests providing an edge region of the substrate 92 with an upper and a lower surface free of both the first and second asphalt compositions as suggested by the Examiner. Applicant respectfully requests that the Examiner provide support for this assertion.

For at least these reasons, Applicant respectfully submits that the rejection in view of Simpson et al. is improper and should be withdrawn.

Claims 25-28 and 31 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Simpson et al. in view of Kennepohl et al. Applicant respectfully submits that Kennepohl et al. does not disclose or suggest the limitations missing from Simpson et al. discussed above. Accordingly, the combination of Simpson et al. and Kennepohl et al. fails to disclose all the limitations of the independent claim and is therefore improper and should be withdrawn.

Claim 23 has been rejected under 35 U.S.C. § 103(a) over

Simpson et al. in view of Kennepohl et al. and in further view of McGroarty et al.

For the reasons discussed at length in the previous responses, Applicant submits that McGroarty et al. does not disclose having anything on the upper surface of the membrane 10.

Membrane 10 is intended to be exposed to the environment, and waterproofing layer 11 is intended to be disposed between the membrane 10 and the roof. The edge region 13 to which the Examiner points to is, and could ONLY be, disposed on the bottom surface of the membrane 10 since the waterproofing layer 11 MUST be on the bottom surface of the membrane 10 in order to properly function as intended. Applicant further submits that the waterproofing layer 11 is NOT an adhesive composition NOR is it an asphalt composition.

For at least the above reasons, Applicant submits that the rejection of claims 21-31 is improper and should be withdrawn. Moreover, Applicant submits that the Restriction Requirement in present Office Action is improper and should be withdrawn, and the remaining claims should be examined on the merits. Since the remaining claims have not been examined on the merits, Applicant submits that it would be improper to make any subsequent office


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action final.

The examiner is invited to telephone the undersigned, applicant's attorney of record, to facilitate advancement of the present application.

Respectfully submitted,

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